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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,308	04/25/2001	Hans Lindenthal	P/3013-6	6700
2352	7590	11/03/2003	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			BINDA, GREGORY JOHN	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/830,308	LINDENTHAL ET AL.
	Examiner Greg Binda	Art Unit 3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 25-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 25-36 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 April 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on 08 September 2003 is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____ .
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The substitute specification filed Feb 24, 2003 has been entered.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Sep 8, 2003 has been entered.

Priority

4. Copies, of the certified copies of the priority documents that were provided to the International Bureau under PCT Rule 17.2(a), have been placed in the application file.

Drawings

5. The drawings are objected to as failing to comply with 37 CFR 1.84(u) because the two separate views in Fig. 1b are not numbered separately.
6. The proposed drawing corrections filed Sep 8, 2003 are approved.

Claim Objections

7. Claims 25 & 32 are objected to because claim 25, line 14 and claim 32, line 12 recite the limitation “the recess being asymmetrical” which applicant argues corresponds to a feature of the disclosed invention as discussed in the interview of Sep 3, 2003 (see Paper No. 12). However, in the interview the examiner simply remarked that in Fig. 1a when viewed in conjunction with Fig. 2a3, the recess 20 appears to be a single recess oriented asymmetrically on the surface 10. The examiner did not say the recess 20 itself is asymmetric. The drawings, see particularly Fig. 1b, do not show the recess 20 being shaped asymmetrically. Fig. 1b does not even appear to show the recess(es?) 20 arranged asymmetrically.

Claim Rejections - 35 USC § 112

8. Claims 29 & 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There does not appear to be a description of the limitations of claim 29 & 36 in the specification as originally filed.

9. Claims 26 & 33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 26 & 33 recite that the position, size and shape of a recess are “determined as

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a function" of a particular set of variables. However, the specification fails to disclose this function. As such undue experimentation would be required of one skilled in the art to determine which function is the function recited in the claim due to the infinite number of functions from which to choose from.

10. Claims 25-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. The terms "high" and "highly" in the claims are relative terms which render the claims indefinite. The terms are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.
- b. Claim 25, line 14 recites the limitation "the recess being asymmetrical" and then claim 29 recites that there is a second recess that is "arranged symmetrically". It appears the claims contradict each other.
- c. Claim 32, line 12 recites the limitation "the recess being asymmetrical" and then claim 36 recites that there is a second recess that is "arranged symmetrically". It appears the claims contradict each other
- d. In order to proceed with this Office action, it is assumed, in view of items b & c above, for the remainder of this action, that the claimed invention comprises at least two recesses arranged symmetrically as recited in claims 29 & 36.

Claim Rejections - 35 USC § 102

11. Claims 25-30 & 32-36 as best understood (see item 10d above) are rejected under 35 U.S.C. 102(b) as being anticipated by Petrzelka et al, US 4,512,679 (Petrzelka '679). Figs. 4 & 5 show an articulated yoke 8 having at least one leg member; one bearing part connected to the leg member including a supporting surface 16 defining a bore 16 therethrough; and a roller bearing arrangement 7 having a plurality of rolling elements (see Fig. 2). Fig. 4 shows the surface 16 includes recesses 12 arranged symmetrically in regions of high stress. Fig. 4 shows the width of the recesses 12 diminishes along the direction of the longitudinal axis 17. In col. 4, lines 33-37, Petrzelka discloses that the recesses are disposed only in the areas of high stress. In col. 4, lines 13-20, the depth of the recesses 12 are disclosed as diminishing along the direction of the longitudinal axis 17. In col. 4, line 13, the recesses are disclosed as being cone-shaped and so are therefore defined by the functions which define the size, shape and profile of a cone (see for example "Cone" on page 139 of *Machinery's Handbook*). As noted by applicant on page 13 of the amendment filed Feb 24, 2003, the recesses 12 can extend along the entire length of the bore 16.

Claim Rejections - 35 U.S.C. § 103

11. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Petrzelka '679 in view of Wintercorn, US 1,700,991. Petrzelka '679 shows bore 16 but does not expressly disclose the bore as a blind hole. On page 4, lines 49-53, Wintercorn teaches making a bore as a blind hole in order to prevent the entrance of dust and to retain lubricant. It would have been obvious to one of ordinary skill in the art to modify the bearing arrangement of Petrzelka '679 by making

the bore as a blind hole in order to prevent the entrance of dust and to retain lubricant as taught by Wintercorn.

Response to Arguments

11. Applicant's arguments filed Sep 8, 2003 have been fully considered but they are not persuasive.

- a. On page 11 of the amendment filed Sep 8, 2003, applicant argues that support for claims 29 & 36 is found on page 15, lines 7-15 of the original specification, but there is no description of features corresponding to the limitations of these claims in that or any other part of the original disclosure.
- b. Applicant argues that one skilled in the art would not need to know the "function" recited in the claims in order to determine the position, profile, shape and/or size of the recess, but could instead could determine the requisite position, profile, shape and size of the recess by observation "over time". However, the argument is unpersuasive because such observation conducted "over time" in and of itself constitutes undue experimentation.
- c. Applicant argues that one skilled in the art would know how to identify a region of high stress by observation over time. Thus it appears applicant is arguing that the claims limits are to be defined definitively not by applicant, but instead by some third party observer who is allowed to determine (subjectively?) for himself what a high stress region is and is not. However, indefiniteness in a claim cannot be overcome by an expectation of observation by one skilled in the art. The claims are read in view of the

disclosure, and therefore must be definite in view of the disclosure, not in view of something outside the bounds of the disclosure (i.e. independent observation/experimentation).

d. Applicant argues that Petrzelka fails to anticipate the claimed invention because Petrzelka fails to show a single recess arranged asymmetrically on the support surface. However, it does not appear the claims recite limitations corresponding to such a feature, nor does it appear the disclosure as a whole would support such limitations. See item 7 above.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (703) 305-2869. The examiner can normally be reached Monday through Thursday from 9:30 am to 7:00 pm. The examiner can also be reached on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne, can be reached on (703) 308-1159. The fax phone number is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



Greg Binda
Primary Examiner
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